



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Secrecy and License to Export

The United States Patent and Trademark Office (USPTO) will submit the following information collection request to the Office of Management and Budget (OMB) for review and clearance in accordance with the Paperwork Reduction Act of 1995, on or after the date of publication of this notice. The USPTO invites comment on this information collection renewal, which helps the USPTO assess the impact of its information collection requirements and minimize the public's reporting burden. Public comments were previously requested via the **Federal Register** on December 27, 2022 during a 60-day comment period. This notice allows for an additional 30 days for public comments.

Agency: United States Patent and Trademark Office, Department of Commerce.

Title: Secrecy and License to Export.

OMB Control Number: 0651-0034.

Needs and Uses: In the interest of national security, patent laws and regulations place certain limitations on the disclosure of information contained in patents and patent applications and on the filing of applications for patents in foreign countries.

A. Secrecy Orders

Whenever the publication or disclosure of an invention by the publication of an application or by the granting of a patent is, in the opinion of the head of an interested Government agency, determined to be detrimental to national security, the Commissioner for Patents at the United States Patent and Trademark Office (USPTO) must issue a secrecy order and withhold the publication of a patent application and the grant of a patent for such period as the national interest requires. A patent will not be issued on the application, nor will the application be published, as long as the secrecy order is in force. If a secrecy order is applied to an international application, the application will not be forwarded to the International Bureau as long as the secrecy order is in effect.

The Commissioner for Patents can issue three types of secrecy orders, each of a different scope. The first type, Secrecy Order and Permit for Foreign Filing in Certain Countries, is intended to permit the widest utilization of the technical data in the patent application while still controlling any publication or disclosure that would result in an unlawful exportation. The second type, the Secrecy Order and Permit for Disclosing Classified Information, is to treat classified technical data presented in a patent application in the same manner as any other classified material. The third type of secrecy order is used where the other types of orders do not apply, including orders issued by direction of agencies other than the Department of Defense.

Under the provision of 35 U.S.C. 181, a secrecy order remains in effect for a period of one year from its date of issuance. A secrecy order may be renewed for additional periods of not more than one year upon notice by a government agency that the national interest continues to so require. The applicant is notified of such renewal.

When the USPTO places a secrecy order on a patent application, the regulations authorize the applicant to petition the USPTO for permits to allow disclosure, modification, or rescission of the secrecy order, or to obtain a general or group permit. In each of these circumstances, the petition is forwarded to the appropriate defense agency for decision. Also, the Commissioner for Patents at the USPTO may rescind any order upon notification by the heads of the departments and the chief officers of the agencies who caused the order to be issued that the disclosure of the invention is no longer deemed detrimental to the national security.

Unless expressly ordered otherwise, action on the application and prosecution by the applicant will proceed during the time the application is under secrecy order to the point indicated in 37 CFR 5.3. See the Manual of Patent Examining Procedure (MPEP) Section 130 (9th ed., rev. 10.2019, June 2020). For example, prosecution of a national application under secrecy order may proceed only to the point where it is found to be in condition for allowance. See 37 CFR 5.3(c). Prosecution of international applications under secrecy order, on the other hand, will proceed only to the point before record and search copies would be transmitted to the international authorities or the applicant. See 37 CFR 5.3(d). National applications under secrecy order that come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. See 37 CFR 5.3(a). Appeals in such cases must be completed by the applicant. Unless specifically ordered by the Commissioner for Patents, these appeals will not be set for hearing until the secrecy order is removed. See *id.*

B. Foreign Filing License

In addition, this information collection covers information gathered with respect to foreign filing licenses. The filing of a patent application is considered a request for a foreign filing license. However, in some instances an applicant may need a license for

filing patent applications in foreign countries prior to a filing in the USPTO or sooner than the anticipated licensing of a pending patent application.

For such circumstances, this information collection covers petitions for a foreign filing license either with or without a corresponding United States application. In addition, this information collection covers petitions to change the scope of a license and petitions for a retroactive license for instances when a patent application is filed through error in a foreign country without the appropriate filing license.

This information collection includes the information needed by the USPTO to review the various types of petitions regarding secrecy orders and foreign filing licenses. This collection of information is required by 35 U.S.C. 181-183 and 184-186 and administered by the USPTO through 37 CFR 5.1-5.5, 5.11-5.15, and 5.18-5.25.

The 60-day notice was published on December 27, 2022. Since that time, two adjustments have been made in the information collection. In response to the Unleashing American Innovators Act of 2022, USPTO reduced eight fees included within this information collection. This reduction was submitted to OMB and approved on 3/28/2023. These fee adjustments are included in the non-hourly cost burdens reflected in the 30-day notice, resulting in a reduction in the *Estimated Total Annual Respondent Non-Hourly Cost Burden* than what appeared in the 60-day notice. Additionally, the two respondent types published in the 60-day notice have been combined into only the private sector; which provides a more accurate estimate of the filers associated with this information collection.

Form Number(s): None.

Type of Review: Extension and revision of a currently approved information collection.

Affected Public: Private sector.

Respondent's Obligation: Required to obtain or retain benefits.

Frequency: On occasion.

Estimated Number of Annual Respondents: 7,524 respondents.

Estimated Number of Annual Responses: 7,524 responses.

Estimated Time per Response: The USPTO estimates that the responses in this information collection will take respondents approximately between 30 minutes (0.5 hours) and 4 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO.

Estimated Total Annual Respondent Burden Hours: 4,503 hours.

Estimated Total Annual Respondent Non-Hourly Cost Burden: \$1,446,446.

This information collection request may be viewed at www.reginfo.gov. Follow the instructions to view Department of Commerce, USPTO information collections currently under review by OMB.

Written comments and recommendations for this information collection should be submitted within 30 days of the publication of this notice on the following website www.reginfo.gov/public/do/PRAMain. Find this particular information collection by selecting “Currently under 30-day Review—Open for Public Comments” or by using the search function and entering either the title of the information collection or the OMB Control Number 0651–0034.

Further information can be obtained by:

- E-mail: InformationCollection@uspto.gov. Include “0651-0034 information request” in the subject line of the message.
- Mail: Justin Isaac, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

Justin Isaac,

Information Collections Officer,

Office of the Chief Administrative Officer,

United States Patent and Trademark Office.

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